

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Status of Claims:

No claims are currently being cancelled.

Claims 1, 5-9, 11 and 12 are currently being amended.

Claims 13-21 are currently being added.

This amendment adds and amends claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claims remain under examination in the application, is presented, with an appropriate defined status identifier.

After adding and amending the claims as set forth above, claims 1-3 and 5-21 are now pending in this application.

Claim Objections:

In the Office Action, claim 9 was objected to because of informalities noted on page 2 of the Office Action. By way of this amendment and reply, claim 9, as well as claims 1, 5-8 and 10-12, have been amended to correct minor informalities found in those claims (such as grammatical differences between British spelling of words and U.S. spelling of those same words). The scope of the claims has not been changed by way of these amendments.

Claim Rejections – Prior Art:

In the Office Action, claims 1-3 and 5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over EP 1 179 811 to Arrieta in view of U.S. Patent No. 6,704,608 to Azuma; claims 6 and 7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Arrieta in view of Azuma and further in view of U.S. Patent Publication No. 2003/0136851 to Habara et al.; claims 8 and 11-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Azuma; and claims 9 and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable

over Habara et al. in view of Azuma. These rejections are traversed with respect to the presently pending claims under rejection, for at least the reasons given below.

With respect to the rejection of claim 1 over the combination of Arrieta and Azuma, Arrieta discloses an embedded RFIP (read-only transponder) that is provided beneath a hologram in a banknote. The Office Action asserts that Arrieta's hologram may correspond to a tamper evident strip, but this is incorrect. There is nothing in Arrieta that teaches or suggests that Arrieta's hologram provides tamper resistance to any component (e.g., the antenna provided beneath the hologram) of the banknote on which the hologram is provided.

The Office Action correctly recognizes that Arrieta does not teach or suggest a memory circuit that is protected from access by an unauthorized reader; however, the Office Action incorrect asserts that Azuma teaches these features.

Azuma discloses a contactless smart card (IC card) with crypto-based mutual authentication. The IC card includes a nonvolatile memory 13 and an encryption circuit 11. The Office Action asserts that Azuma teaches mutual authentication for increased security, and incorrectly interprets this to include protecting access from an unauthorized reader. The mutual authentication for increased security, as taught by Azuma, does not stop physical tampering of the smart card by someone. When an unauthorized user of Azuma's smart card tries to use that card for making a credit card purchase, for example, the unauthorized user presumably will not be able to provide information that is used in the mutual authentication procedure of Azuma; however, this has nothing to do with indicating when physical tampering (e.g., trying to replace a magnetic strip of the smart card with another magnetic strip) of the smart card has occurred.

It is also noted that Arrieta, which is directed to producing a security document having a hologram, and Azuma, which is directed to providing an IC card with a nonvolatile memory and an encryption circuit for providing mutual authentication, are directed to much different purposes. Thus, one skilled in the art at the time the invention was made would not be motivated to combine these two references. However, even if one skilled in the art would be

motivated to combine these references, as explained above, that combination would not be relevant to the features recited in claim 1.

Accordingly, presently pending independent claim 1 is patentable over the combination of Arrieta and Azuma.

With respect to the rejection of dependent claims 6 and 7 based on the combination of Arrieta, Azuma and Habara et al., the Office Action asserts that the Abstract of Habara et al. teaches that a document is used to identify/authenticate an authorized bearer of the document. The Office Action further asserts that “Though silent to the document allowing access to asset(s), the Examiner notes that intended use is not patentable.” In view of this statement made in the Office Action, claim 7 has been amended to positively recite means for allowing access to a specified asset or assets by the authorized bearer.

Accordingly, the features recited in claim 7 must be given patentable weight, whereby those features are not taught or suggested by Habara et al., or by any of the other cited art of record. It is also noted that the Office Action appears to state that the features recited in claim 7 “are well known and conventional in the art,” but such an assertion without support in a prior art document is not a proper basis for rejecting a claim. If the Examiner is to maintain this rejection, he is respectfully requested to find a prior art reference that teaches such features, or otherwise withdraw this rejection.

With respect to the rejection of claims 8, 11 and 12 based on Azuma, the Office Action asserts that Azuma discloses writing second information to one or more memory circuits configured to be read wirelessly for attachment to or incorporation within the printed document. Applicants respectfully disagree. Azuma’s smart card does not correspond to a ‘printed’ document, since there is no printing to be done on the smart card. As such, the one or more memory circuits provided in Azuma’s smart card are not attached to or incorporated into a printed document, since they are a part of an integrated circuit, also referred to as a smart card. Azuma’s memory circuit 13, which is asserted in the Office Action as corresponding to a memory circuit that is attached to or incorporated in a printed document, is

provided in the one-chip IC, as clearly seen in Figure 2 of Azuma. A one-chip IC does not correspond to a printed document.

Accordingly, claim 8 is patentable over the teachings of Azuma.

With respect to the assertions made on page 5 of the Office Action for claims 11 and 12, Applicants strongly disagree with the assertions that it is conventional to attach circuits in/on the card/document as is conventional in the art to store information. The fact that a smart card has memory circuits provided therein, is not pertinent to claims 11 and 12, since the smart card is not a printed document (nothing is being printed on the smart card), but rather it is a device that may allow printing onto a document.

Accordingly, claims 11 and 12 are patentable over the teachings of Azuma.

With respect to the rejection of claims 9 and 10 based on the combined teachings of Habara et al. and Azuma, paragraph 0052 of Habara et al., which teaches that a guard checks printed information on a card body 60 of an ID 6, to determine if a holder of the ID 6 is authorized to enter a building, is not pertinent to the features recited in claims 11 and 12, since the data printed on the card body 60 of the ID 6 of Habara et al. does not correspond to wirelessly powering a memory circuit on the ID 6 and wireless reading protected information stored in the memory circuit. Rather, a guard visually checks information obtained from the ID 6 (and displayed on a display accessible by the guard) with information obtained from a visual inspection of the holder of the ID 6, to see if the holder of the ID 6 is the correct person who was previously issued the ID 6.

Since Azuma does not rectify the above-mentioned shortcomings of Habara et al., claims 9 and 10 are patentable over the combination of those two references.

New Claims:

New claims 13-21 have been added to recite additional features of the present invention that are believed to provide a separate basis of patentability for those claims, beyond the reasons given above for their respective base claim.

Conclusion:

Since all of the issues raised in the Office Action have been addressed in this Amendment and Reply, Applicants believe that the present application is now in condition for allowance, and an early indication of allowance is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorize payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date February 13, 2006

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